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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,993	09/11/2003	Michael A. Sharo	CE11149J1211	4645

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MOTOROLA, INC  
INTELLECTUAL PROPERTY SECTION  
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EXAMINER

TRINH, TAN H

ART UNIT PAPER NUMBER

2618

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/659,993	SHARO, MICHAEL A.	
	<b>Examiner</b>	<b>Art Unit</b>	
	TAN TRINH	2684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement (IDS) submitted on 03-08-2004, the information disclosure statement is being considered by the examiner.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 8-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishop (U.S. Patent No. 5563931) in view of Higuchi (U.S. Patent No. 6275690).

Regarding claim 1, Bishop teaches a method for providing a reply to a dispatch call (see fig. 1, dispatch call center 47) transmitted by a first radio (see fig. 1, first radio 41, col. 11, lines 28-60), comprising the steps of: receiving the dispatch call at a second radio (see fig. 1, second radio 39 (phone 61), col. 17, lines 8-23); But Bishop fails to teach the transmitting a preprogrammed voice message by the second radio.

However, Higuchi teach the transmitting a preprogrammed voice message by the second radio (see fig. 9, receiving incoming call 85, generate response information 87 and transmit response information 88, col. 2, lines 19-41, col. 4, lines 5-8, and col. 11, lines 35-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Bishop with Higuchi, in order to provide user with to transmit a message to a calling party without operating phone each time the reception of incoming call is notified (see Higuchi col. 11, lines 50-53).

Regarding claim 2. Higuchi teaches is performed automatically (see col. 2, lines 38-41 and col. 4, lines 5-8).

Regarding claim 3. Higuchi teaches wherein the voice message transmitted in step (b) is selected from amongst a plurality of voice messages stored in the second radio (see col. 2, lines 19-41).

Regarding claim 4. Higuchi teaches wherein the second radio stores a record of the voice message that was transmitted (see col. 6, lines 60-67).

Regarding claim 5. Higuchi teaches wherein the record of the voice message transmitted is stored in a recent calls list (see list of the message at col. 7, lines 1-10).

Regarding claim 6. Higuchi teaches wherein the user of the second radio manually selects the preprogrammed message that is transmitted (see col. 6, lines 60-67).

Regarding claim 8. Higuchi teaches wherein the preprogrammed message transmitted in step (b) is a voice message that is recorded by the user of the second radio (see 3B, col. 8, lines 15-28 and col. 7, lines 26-40).

Regarding claim 9. Higuchi teaches wherein the voice message transmitted in step (b) is selected from amongst a plurality of voice messages stored in the second radio and the voice message transmitted in step (b) is automatically transmitted and selected given the identification number of the first radio (see col. 2, lines 19-41, col. 4, lines 5-8 and col. 10, lines 29-34). (he identification number of the first radio is the calling ID, since the incoming call displaying time date for cellular mobile is also display the calling number).

Regarding claim 10, Bishop teaches a radio that can transmit and receive dispatch calls (see fig. 10, dispatch calls 47 and a radio 61), comprising: a receiver; a transmitter coupled to the receiver (see fig. 9, transceiver 93); a memory coupled to the receiver (see fig. 9, memory 95), stored within the memory is at least one preprogrammed voice message (see “meet me” col. 17, lines 15-23); and responsive to a dispatch call being received at the receiver that was transmitted by a second radio (see fig. 10, col. 17, lines 8-23). But Bishop is not clearly teaching for using the transmitter to transmit the at least one preprogrammed voice message of the second radio (61).

However, Higuchi teaches the transmitting a preprogrammed voice message by the second radio (see fig. 9, receiving incoming call 85, generate response information 87 and transmit response information 88, col. 2, lines 19-41, col. 4, lines 5-8, and col. 11, lines 35-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Bishop with Higuchi, in order to provide user with to transmit a message to a calling party without operating phone each time the reception of incoming call is notified (see Higuchi col. 11, lines 50-53).

Regarding claim 11, Higuchi teaches wherein the at least one preprogrammed voice message is automatically transmitted by the transmitter upon the dispatch call being received at the receiver (see col. 2, lines 38-41 and col. 4, lines 5-8). (Since the combination of Bishop teaches dispatch call and Higuchi teaches the preprogrammed voice message is automatically transmitted the response message, the combined is teaching the limitation).

Regarding claim 12, Higuchi teaches wherein the at least one preprogrammed voice message is transmitted after the dispatch call has been received at the receiver and after it has been manually selected (see col. 6, lines 60-67).

Regarding claim 13, Bishop teaches wherein the radio can receive both dispatch calls and cellular calls (see fig. 7, col. 18, lines 28-41).

Regarding claim 14, Higuchi teaches wherein the at least one preprogrammed message is recorded by the user of the radio (see 3B, col. 8, lines 15-28 and col. 7, lines 26-40).

Regarding claim 15, Bishop teaches a radio that can receive both half-duplex dispatch and full-duplex cellular calls (see fig. 10, a radio 61, paging system for dispatch call is half-duplex and cellular calls is full-duplex, see col. 1, lines 52-67, and col. 18, lines 28-64), the radio comprising: a memory, stored within the memory are a plurality of preprogrammed voice messages (see fig. 9, memory 95); a transmitter; a receiver coupled to the transmitter and memory (see fig. 9, transceiver 93 and memory 95 are coupled). But Bishop is not clearly teaching for using and the transmitter automatically transmits one of the plurality of preprogrammed voice messages in response to the receiver receiving a dispatch call if an automatic reply mode has been selected on the responses incoming calls.

However, Higuchi teaches the transmitter automatically transmits one of plurality of preprogrammed voice message by the second radio response incoming calls (see fig. 9, receiving incoming call 85, generate response information 87 and transmit response information 88, see col. 2, lines 19-41, col. 4, lines 5-8, and col. 11, lines 35-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Bishop with Higuchi, in order to provide user with to transmit a message to a calling party without operating phone each time the reception of incoming call is notified (see Higuchi col. 11, lines 50-53).

Regarding claim 16, Higuchi teaches wherein the radio user instead of selecting the automatic reply mode places the radio in a manual response mode which allows the radio user to select from amongst the plurality of preprogrammed voice messages the message the user wants to transmit in response to receiving the dispatch call (see col. 6, lines 60-67). (Since the

combination of Bishop teaches dispatch call and Higuchi teaches the preprogrammed voice message is automatically or manual response transmitted the response message, the combined is teaching the limitation).

Regarding claim 17, Bishop teaches wherein instead of having one of the plurality of preprogrammed voice messages being automatically transmitted in response to receiving the dispatch call the user of the radio inactivates the automatic reply mode and can respond to the dispatch call and begin communications with the radio that sent the dispatch call (see fig. 7, col. 16, lines 57- col. 17, lines 8).

Regarding claim 18, Higuchi teaches wherein the radio user manually selects one of the plurality of preprogrammed voice messages and transmit the manually selected message in response to receiving the dispatch call (see col. 6, lines 60-67).

Regarding claim 19, Higuchi teaches wherein the plurality of preprogrammed voice messages are programmed by the radio user (see 3B, col. 8, lines 15-28 and col. 7, lines 26-40).

Regarding claim 20, Higuchi teaches wherein the plurality of preprogrammed voice message are labeled and are selected using a menu (see fig. 2 and 3A, preprogrammed voice message are labeled (assigned), F1, F2 and F3, for message send by selected by user depress the function key, col. 7, lines 1-10).



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4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bishop (U.S. Patent No. 5563931) in view of Higuchi (U.S. Patent No. 6275690) further in view of Crockett (U.S. pub. No. 20030154249).

Regarding claim 7, Bishop and Higuchi teaches wherein the preprogrammed message is transmitted once the radio user. But Bishop or Higuchi fails to transmit once the radio user activates a Push-To-Talk (PTT) switch located in radio.

However, Crockett to transmit once the radio user activates a Push-To-Talk (PTT) switch located in radio (see fig. 1 and fig. 4, item 402 selects member list and presses PTT, page 7, sections [0112] and [0118]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above combination of Bishop and Higuchi with Crockett, in order to provide user with transmit a message using push-to-talk phone (Crockett page 11, section [050]).

### ***Conclusion***

5. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(571) 273-8300, (for Technology Center 2600 only)**

*Hand-delivered responses should be brought to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).*

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Trinh whose telephone number is (571) 272-7888. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Anderson, Matthew D., can be reached at (571) 272-4177.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600 Customer Service Office** whose telephone number is (703) 306-0377.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tan H. Trinh   
Division 2618  
June 23, 2006

Anderson, Matthew D. (SPE 2618)

